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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,613	11/19/2003	Bennett J. Beer		4845

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Bennett J. Beer
Computer Expressions
3500 Scotts Lane
Philadelphia, PA 19129

EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

87

Office Action Summary	Application No.	Applicant(s)	
	10/715,613	BEER, BENNETT J.	
	Examiner	Art Unit	
	Jila M Mohandesi	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 2 is objected to because of the following informalities: In claim 2, "stuffed" appears to be - - stuffed - -. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, the phrase "product-holder interface panel" is vague and indefinite. It is not clear what structure such language encompasses. In claim 2, the phrase "a standardized insert" is vague and indefinite. It is not clear what structure such language encompasses.

In claim 6, the phrase generic product holder" is vague and indefinite. It is not clear what structure such language encompasses.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-15 of copending Application No. 10/774,138. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim the combination of a three-dimensional stuffed or plush article and a product holder interface panel and a generic product holder permanently attached.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Mayne (5,525,088). Mayne '088 discloses an addition to three-dimensional stuffed or plush articles designed to incorporate a product-holder interface panel.

8. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Youngs (4,850,731). Youngs '731 discloses an addition to three-dimensional stuffed or plush articles designed to incorporate a product-holder interface panel.

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9. Claims 1-3 and 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Northway et al. (5,743,500). Northway '500 discloses an addition to three-dimensional stuffed or plush articles designed to incorporate a product-holder interface panel.
10. Claims 1-3 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Crowell (5,613,312). Crowell '312 discloses an addition to three-dimensional stuffed or plush articles designed to incorporate a product-holder interface panel.
11. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Hodge (5,842,900). Hodge '900 discloses an addition to three-dimensional stuffed or plush articles designed to incorporate a product-holder interface panel (22) as part of a secondary assembly (10); the product-holder interface panel (22) is a standardized insert attached in a temporary fashion (e.g. by hook-and-loop fasteners) to said three-dimensional stuffed or plush articles); said secondary assembly (10) forms a part of the aesthetic representation (e.g. the caricature represented in figures 1-3, for example) thereof; said product-holder interface panel (22) has product holders (30, 32) permanently attached (via stitching) thereof; commonly available and thus standardized photograph holders (30, 32) permanently attached (via stitching) to said product-holder interface panel (22); a closure mechanism (140, 142) is engaged to contain and protect said product-holder interface panel (22) and permanent attachment (e.g. stitching) thereof from handling and damage.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hodge '900 in view of Tai et al (5,046,980). Hodge '900 as described above discloses all the limitations of the claims except for a handle. Tai '980 discloses a stuffed toy that doubles as a carrying article (column 2, lines 7-10). The stuffed toy includes a handle (12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a handle to the three dimensional stuffed or plush article of Hodge '900 as taught by Tai '980 to permit the stuffed toy to be carried from one place to another.

Conclusion


14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are additions to three-dimensional articles analogous to applicant's instant invention.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**JILA M. MOHANDESI
PRIMARY EXAMINER**


Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
March 30, 2005